

REMARKS

This is a response to the Office Action dated January 13, 2005. Claims 1-15 are pending in the application and stand rejected.

Summary of Examiner's Action and Response

The Examiner rejected Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over Huffman et al. (U.S. Patent No. 5,893,132) in view of Burke (U.S. Patent Pub. No. 2002/0167534 A1 filed 5/10/2001). The Applicant has reviewed these prior art references, and the rejection is respectfully traversed.

Response to Rejection of Claims 1-15 under 35 U.S.C §103

The Examiner rejected Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over Huffman et al. (U.S. Patent No. 5,893,132) in view of Burke (U.S. Patent Pub. No. 2002/0167534 A1 filed 5/10/2001). Applicant respectfully submits that application of section 103 is improper in this case.

It is axiomatic that the prior art to be considered under section 103 must be analyzed in the absence of any teaching from the claimed invention. Such an evaluation requires the often difficult task of excluding anything taught or suggested by the present invention from one's mind. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (Fed.Cir.1985).

In the abstract, this proposition is straightforward. However, courts have often struggled in applying it to relatively simple inventions. This is true because a relatively simple invention - once revealed by its creator - is easily understood. Thereafter, one is prone "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed.Cir.

983).

The United States Court of Appeals for the Federal Circuit recently discussed this issue in the case of *In Re Dembiczak*, 175 F.3d 994 (Fed.Cir. 2000), *limited on other grounds by In Re Gartside*, 203 F.3d 1305 (Fed.Cir.2000). *Dembiczak* involved a patent claim on the now-familiar orange trash bags with the printed Jack-O-Lantern faces.

The Dembiczak patent application was rejected by the U.S.P.T.O., then rejected by the Board of Patent Appeals and Interferences. In reversing these decisions, the Federal Circuit noted that “[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Id.* at 999.

The evidence of a suggestion, teaching, or motivation to combine prior art references must be established in order to set forth a prima facie case of obviousness. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed.Cir.1985). This evidence must come from the prior art references themselves, the knowledge of one who is skilled in the art, or from the suggestions inherent in the nature of a problem to be solved. *ProMold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed.Cir.1996). The suggestion of combination generally comes from the teachings within the references themselves. *In Re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998).

Applicant has reviewed the prior art references cited by the Examiner and has found no suggestion or teaching supporting the modification of prior art references as cited by the Examiner. The Applicant respectfully submits that the requirements for a prima facie case of obviousness have not been established in this case. Instead, the Applicant suggests that the P.T.O has fallen into the trap the *Dembiczak* opinion warns so sternly against - that of using the inventor’s own disclosure to suggest combinations in order to defeat patentability.

Additionally, a prior art reference does not create a case of prima facie obviousness if it fails to disclose a material element or limitation claimed in the present invention. *In re Evanega*, 829 F.2d 1110 (Fed. Cir. 1987). Applicant respectfully submits that the prior art does not include all material elements of limitations claimed in the present invention.

The Examiner cited Huffman (Col 19 lines 9-20) for teaching the method step recited in claim 1 for “defining criteria for the appropriate selection of said emphasized text.” Applicant respectfully submits that Huffman does not teach this limitation recited in claim 1. The section of Huffman’s description that the Examiner is referring to describes an operation performed by block 482 (and resulting operations based on the result of the operation performed by block 482). A more accurate description is that Huffman teaches providing a criteria for operating a program based on the selection of text by a user.

The “defining criteria” limitation of claim 1 refers to criteria the user will use in order to determine which text is appropriate to select. This is better understood by reference to Applicant’s specification, where it provides “The users are then given a set of criteria for evaluating the text. In this particular example, the users are asked to emphasize portions of the text believed to be important.” (Page 5, lines 1-3). Other examples of “defining criteria” are provided in Examples One, Two, and Three. In Example One, “defining criteria” relates to the selection of text based on whether the text represents a claim, a support, and a warrant. In Example Two, “defining criteria” relates to the selection of portions of a contractual document that the person believed to be important. In Example Three, “defining criteria” relates to selection of text based on whether it was a part of the legislation that the constituent liked or did not like.

Accordingly, Applicant respectfully submits that Huffman would be an appropriate reference for this limitation only if Huffman taught defining criteria for selection of text (i.e. the

user uses the criteria to determine which text to select).

The Examiner cited Burke for the limitation recited in claim 1 which provides for “analyzing said emphasis-modified tests for all of said users in order to determine how many of said users elected to emphasize a particular word within said larger body of text.” Applicant respectfully submits that Burke does not teach this limitation. The Examiner referred to paragraph 0057 of Burke which simply explains that Burke’s reading aid can be used in connection with reading exercises of an audience of several people. Burke teaches a method for emphasizing text, but does not teach analyzing text to determine how many of the users elected a particular word within the larger body of text.

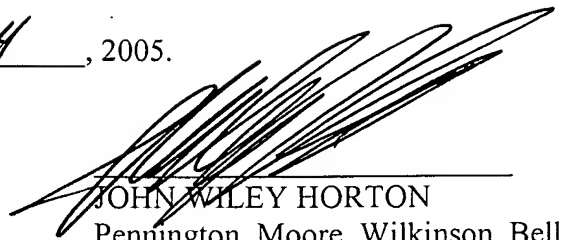
Similarly Applicant submits that Burke further does not teach the limitation recited in claim 1 which provides for “visually displaying the result of said analyzing, using a plurality of graduated emphasis elements to indicate an increasing level of consensus as to said selected portions. As stated above, Burke does teach a method for emphasizing text, but does not teach using emphasis elements “to indicate an increasing level of consensus” to the selected portions.

The aforementioned limitations represent novel and nonobvious elements of the present invention. Accordingly, with the before mentioned legal authority in mind, Applicant respectfully submits that the rejection of claim 1 should be removed. Since Claims 2-16 are also dependent on Claim 1, they should also be allowed.

Conclusion

In view of the above remarks, the Applicant believes that the claims are in condition for allowance. Accordingly, the Applicant respectfully requests that the Examiner reconsider the rejections.

Respectfully submitted this 22nd day of MARCH, 2005.



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